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Alan B. Clement		EXAMINER		
Locke Lord Bissell & Liddell LLP		WILLIAMS, JAMILA O		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,252	Applicant(s) POLICK, PETER	
	Examiner Jamila Williams	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-19, 21, 22, 26, 27, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-19, 21, 22, 26, 27, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>marked figure</u> . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12, 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear from the claims what is encompassed by the phrases towards "a second half of said first whole sheet"; "a second half of a sheet"; "a second half of said second whole sheet".

In claims 17-18 it is not clear how "the book of claim 1 further comprising at least one double gate fold comprising a whole sheet folded into quarter sections..." and "further comprising at least one single gatefold comprising a whole sheet folded in thirds...". It appears that applicant may be combining multiple embodiments with the embodiment of claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 6, 7, 15-18, 21, 22, 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by 5,141,253 to Rice.

Rice discloses a book containing at least one removable panel (41, in that the sheets 21 and 51 are not sealed along the top edge, the panel 41 is capable of being removed see figures 6-7) and at least one pocket containing leaf (formed by sheet 21 and 51). The front wall of the pocket comprising a first outer surface comprising a first part of a first page (21) and a first inner surface comprising a second part of the first page (surface of 21 shown in figure 2 is the inner surface) ,the second part of the first page is the reverse side of the first part of the first page and the back wall of the pocket comprising a second outer surface comprising a first part of a second page (51 is considered to be the second page) and a second inner surface comprising a second part of the second page (the inner surface is the surface of 51 shown in figure 2), the second part of the second page is the reverse side of the first part of the second page, the front and back walls adhered to form a pocket (see figure 5). Rice discloses having predetermined indicia on at least one of the pages (see fig. 3) and at least one aperture (53), wherein the panel comprises at least one panel indicia field (areas where indicia 45 is located makes up an indicia field) and the aperture (53) is positioned in aligned relation to one of the panel indicia fields when inserted into the pocket (figs 3-4), as recited in claim 1.

Regarding claims 3-4, Rice discloses the front and back walls (21,51) are fastened directly to one another along reciprocal facing perimeter sections of the front and back walls (fig 5) and a spacer (64) is disposed between the front and back walls (fig 5 and col. 8 lines 45-68 of the specification).

Regarding claim 5 see rejections of claims 1 and 4 above.

Regarding claim 6, the panel (41) comprises panel indicia disposed within at least one of the indicia fields (indicia 45).

Regarding claim 7, the panel of Rice is inherently capable of receiving user-created panel indicia within at least one of the indicia fields.

Regarding claim 15, Rice discloses a separate cover (cover of publication 11), the second half of the first whole sheet and second half of the second whole sheet are bound to an inside of the front and back portion of the cover (all bound along the spine which is inside the cover).

Regarding claim 16, see rejection of claim 15 above.

Regarding claim 17, Rice discloses further comprising at least one double gatefold comprising a whole sheet folded into quarter sections, the whole sheet comprising a first section (61 that operates as a gatefold via perforations 62-63), a second section (21), a third section (41) and a fourth section (51 that operates as a gatefold via perforation 52).

Regarding claim 18, Rice discloses at least one single gatefold comprising a whole sheet folded into thirds, the whole sheet comprising first section (61 that operates as a gatefold via perforations 62-63), second section (21) and third section (41).

Regarding claims 21-22 and 26-27, Rice discloses that the at least one page and panel indicia comprises story-based predetermined indicia and indicia relating to educational categories (in that the indicia of Rice tells a story and educates the user about a product, this indicia satisfies the requirement of being story based or relating to an educational category- i.e. English or reading).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,6-8,12,13,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,540,260 to Tan in view of 5,947,522 to Boehm and further in view of 4,736,536 to Doman.

Tan discloses a book (photo album) comprising at least one removable panel (photo) and at least one pocket containing leaf (figure 7 of Tan). The pocket containing leaf comprising a front and back wall (front wall formed by half of sheet 64 see figures 3 and 8 and the back wall is formed by half of sheet 58 see figures 6 and 8 of Tan) to thereby form a pocket disposed between the front and back wall (figure 8 of Tan), the pocket adapted to removably receive the panel (figure 8 and column 2 lines 1-3 of Tan). The front wall comprising a first outer surface of a first part of a first page (looking at figure 8 first part of sheet 64 forms top of pocket) and a first inner surface comprising a second part of the first page, the second part of the first page is the reverse side of the first part of the first page (reverse side of the first part of 64) and the back wall comprising a second outer surface of a first part of a second page (figures 7-8 of Tan, back wall formed by 58- which is the second page in figure 8), a second inner surface

comprising a second part of the second page, the second part of the second page is the reverse side of the first part of the second page (reverse side of 58 in figure 8, see marked copy), wherein a portion of the front wall is adhered to a portion of the back wall thereby forming a pocket (glue 70), at least one of the pages comprise at least one aperture (figure 3 and 7, sheet 64 of Tan).

Tan does not however disclose the removable panel comprising at least one panel indicia field, the aperture is positioned in aligned relation to the panel indicia field when the panel is inserted into the pocket, and having predefined indicia on at least one of the pages outer surfaces, as recited in claim 1.

Boehm teaches having an album page with predefined indicia on an outer surface (figures 5a,b for example of Boehm). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the predefined indicia of Boehm with the page of Tan for the purpose of providing a theme or information about the photograph.

Doman teaches having a photograph (which is being considered the claimed panel) with at least one panel indicia field (Subject field in figure 1 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the panel indicia field of Doman with the panel or photograph of Tan modified by Boehm for the purpose of associating information with the panel or photograph. This modification would further provide alignment of the panel indicia field and aperture of the pocket when the panel or photograph is inserted therein (it is noted

that Doman teaches that the indicia is viewable simultaneously with the front of the photograph when mounted in a frame or album- column 4 lines 40-44 of Doman).

Tan modified by Boehm and Doman discloses the front and back wall are fastened directly to one another along reciprocal facing perimeter sections of the front and back walls (Tan figure 7 see glue 70), as recited in claim 3.

Tan modified by Boehm and Doman discloses the panel further comprises panel indicia disposed within at least one of the indicia fields and the panel is adapted to receive user-created panel indicia within at least one indicia field(column 3 lines 26-30 of Doman), as recited in claims 6-7.

Tan modified by Boehm and Doman discloses the panel further comprises categorical indicia to assist a user in selecting the user defined indicia (Date in figure 1 can be considered categorical indicia), as recited in claim 8.

Tan modified by Boehm and Doman discloses a second half of the first whole sheet operates as a front cover (looking at figure 7, the second half of sheet 64 operates as a cover) and the second half of a sheet operates as a back cover (second part of 58- only partially shown in figure 8 forms a back cover), as recited in claim 12.

Tan modified by Boehm and Doman discloses further comprising a first pocket containing leaf and a last pocket containing leaf (looking at figure 7, the first set of sheets being the a first pocket containing leaf and the last sheet set where reference number 56 is pointing being the last pocket containing leaf), as recited in claim 13.

Regarding claim 15, Tan modified by Boehm, Doman and Heimann discloses a separate cover (shown in figure 14, 16) wherein a second half of the first whole sheet is bound to the inside of a front portion of the cover and a second half of the second whole sheet is bound to an inside of a back portion of the cover (the sheets are bound to the inside of the cover by binding members in the spine area of figure 16).

Claims 4-5, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tan in view of Boehm, in view of Doman and further in view of 2,944,356 to Anthon. Tan and Boehm disclose all of the elements of the claims as applied to claim 1 above. These references do not however disclose having a spacer between the front and back walls of the pocket. Anthon teaches having a spacer between the sheets of a pocket (col. 2 line 72 and col. 3 lines 1-7 of the specification). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the spacer of Anthon with the pocket of Tan modified by Boehm and Doman for the purpose of spacing the sheets of the pocket such that the panels can be easier inserted and removed therefrom.

Regarding claim 29, Tan modified by Boehm, Doman and Anthon discloses populating the indicia fields with user-defined indicia without reference to predefined indicia (Doman teaches inserting user defined indicia without reference indicia on the album for example), inserting the panel comprising the user populated indicia fields into the pocket (Doman column 4 lines 40-41 teaches placing the panel or photograph in an

album, figure 8 of Tan shows a photograph or panel inserted into a pocket of a photo album), viewing the pre-defined and user defined indicia combinations (Boehm shows pre-defined indicia on the pocket- figure 5 for example and Doman provides for the user defined indicia).

Regarding claim 30, in that Tan modified by Boehm, Doman and Anthon disclose having the indicia on the pocket (predefined indicia) and on the panel or photograph (user defined indicia) it would have been obvious to one having ordinary skill in the art at the time the invention was made to populate the user defined indicia fields with reference to the predefined indicia as suited for the intended use and for the purpose of providing an association or relationship between the panel and pocket. Additionally it that the photographs (which are being considered by the examiner to be claimed panels) are moveable from one pocket to the other it would have been obvious to one having ordinary skill in the art at the time the invention was made to move the photographs from one pocket to another for the purpose of indexing or organizing the photographs as suited by the intended use.

Claims 9-10,14,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tan in view of Boehm, in view of Doman and further in view of 3924744 to Heimann. Tan modified by Boehm and Doman disclose the elements of the claims but for the tabular section and indicia. Heimann teaches having a tabular section with indicia associated with the edge of a substrate (tab 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the tabular

section of Heimann with the substrate of Tan modified by Boehm and Doman for the purpose of indexing the panels.

Regarding the specific indicia on the tab (i.e. tabular indicia and panel indicia related to common theme), Tan modified by Boehm, Doman and Heimann disclose the claimed invention except for the specific arrangement and/or content of indicia (tabular indicia, panel indicia with common theme) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the tab or panel comprising indicia is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. indicia) and the substrate (e.g. tab or panel) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

Regarding claim 14, Tan modified by Boehm, Doman and Heimann discloses a second half of the first whole sheet of the first pocket-containing leaf operates at a front cover (looking at figure 7, the second half of sheet 64 operates as a cover) and a second half of the second whole sheet of the last pocket containing leaf operates as a back cover (second part of 58- only partially shown in figure 8 forms a back cover)

Regarding claim 16, Tan modified by Boehm, Doman and Heimann discloses a separate cover (shown in figure 14, 16) wherein a second half of the first whole sheet is bound to the inside of a front portion of the cover and a second half of the second whole sheet is bound to an inside of a back portion of the cover (the sheets are bound to the inside of the cover by binding members in the spine area of figure 16).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tan in view of Boehm, in view of Doman in view of 2,944,356 to Anthon and further in view of 2,438,048 to Graham or 893,353 to McGill. Tan modified by Boehm, Doman and Anthon disclose all of the elements of the claims including having a spacer. These references do not however disclose having a locking mechanism capable of securing the panel in the pocket. Both Graham and McGill teach having locking mechanisms (fig 1 to McGill and fig 3 to Graham show clips that attach to sheets for securing them into position- this satisfies the locking mechanism of applicant- to the degree claimed). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the locking mechanism of either McGill or Graham with the spacer of

Tan modified by Boehm, Doman and Anthon for the purpose of securing the panel in the pocket.

Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rice in view of 5,951,298 to Werzberger. Both Rice disclose all of the elements of the claims as applied to claim 1 above. Neither of these references however disclose having a closing means on the aperture. Werzberger teaches having closing means (flaps 22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the closing means of Werzberger with the apertures of Rice or Betancourt for the purpose of selectively displaying the indicia.

Response to Arguments

Applicant's arguments filed 10-4-2007 have been fully considered but moot in view of new grounds of rejection.

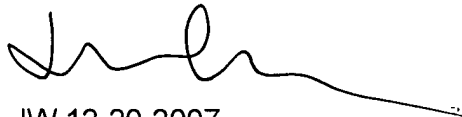
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

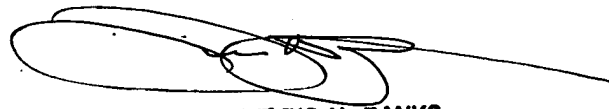
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JW 12-20-2007



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FIG 7

